

REQUEST FOR RECONSIDERATION

Reconsideration of the present application is respectfully requested.

Claims 1-7 are currently pending in this application. It is gratefully acknowledged that the Examiner has allowed Claims 4-7. The Examiner has maintained his rejection of Claims 1-3 under 35 U.S.C. §103(a) as unpatentable over Krishnamurthi et al. (U.S. 6,134,434, hereinafter *Krishnamurthi* '434) in view of Krishnamurthi et al. (U.S. Patent 6,198,929, hereinafter *Krishnamurthi* '929), as well as his rejection of Claims 1-3 under 35 U.S.C. §102(e) as anticipated by *Krishnamurthi* '929.

Regarding the rejection of independent Claim 1 under §103(a), the Applicant initially sets forth that under §103(a) scrutiny, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of obviousness. In the present case, Applicant respectfully asserts that several of the limitations of the rejected claims are not taught or suggested by the prior art. Particularly, the Examiner asserts that *Krishnamurthi* '434 teaches all of the elements of Claim 1, except for including a service type identifier indicating a concurrent service of the voice and packet data, sending from the first base station a new service identifier, and forming in the mobile station a communication link to the second base station, based on the new service configuration record, which the Examiner asserts is disclosed by *Krishnamurthi* '929. Independent Claim 1 is directed to a method for handing off a mobile station (MS) that is concurrently (i.e. at the same time) receiving voice and packet data. As such, when a handoff is necessary a target base station (BS) (or second BS) must determine if it can continue to provide the concurrent services, (i.e. voice and packet data) to the MS. According to the present invention, the target BS makes this determination using a service type identifier indicating a concurrent service of the voice and packet data and a service configuration record received from an MSC. If the target BS cannot continue to provide the concurrent service, the BS then creates a new service type identifier and a new service configuration record, which are used to indicate that the target BS can provide one of the previous services to the MS, and are used by the MS to connect to the target BS. *Krishnamurthi* '434 does not disclose this method, and these defects are not cured by *Krishnamurthi* '929.

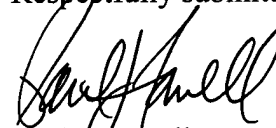
In the final Office Action, responding to the argument that *Krishnamurthi* '929 does not disclose a concurrently provided service type of the present claims, the Examiner alleged that since voice and SMS calls are multiplexed in *Krishnamurthi* '929, then the reference discloses a concurrently provided service type. In the present Claim 1, *in a method for performing a handoff*, a handoff required message indicating a *concurrent* service of voice and packet data and a service configuration record, is sent from a BS1 to the MSC. Contrary to the Examiner's allegation, *Krishnamurthi* '929 makes no disclosure of the presently claimed limitation of performing a handoff when concurrently transmitting voice and packet data. It is respectfully asserted that mere multiplexing of voice and SMS calls does not meet, or even fairly suggest, the stated limitation of Claim 1. The Examiner further alleges in the Response to Arguments that one skilled in the art would recognize that radio resource information is an SMS message, and that a service type identifier is part of the configuration record in *Krishnamurthi* '929. It is respectfully submitted and asserted that one skilled in the art would not make such recognitions. The Examiner pointed to virtually an entire column (col.3, lns.9-55) as proof of his allegation, but his allegation is not taught or suggested anywhere in that column.

Moreover, the Examiner's rejection incorrectly reasons that since voice and packet data are disclosed in *Krishnamurthi* '929, and the Service Configuration Directive allegedly contains the service configuration, then it would have been obvious to include a service type identifier indicating a concurrent service of voice and packet data in *Krishnamurthi* '434. There is also no recitation in either *Krishnamurthi* '434 or *Krishnamurthi* '929 of the second base station determining whether it is possible to communicate with the mobile station using a radio resource specified in the service type identifier and the service configuration record, and sending, when it is not possible to communicate with the mobile station, to the mobile switching center a new service type identifier and a new service configuration record indicating that communicating with one of the voice and packet data with the mobile station is possible. These are further claimed limitations missing in *Krishnamurthi* '434 and *Krishnamurthi* '929. For at least the foregoing reasons, the rejection of Claims 1-3 under 35 U.S.C. §103(a) should be withdrawn.

Regarding the rejection of Claims 1-3 under 102(e), the Examiner asserts that *Krishnamurthi '929* anticipates all of the elements of Claim 1. Based on at least the arguments set forth above, and the aforementioned missing limitations of the present Claim 1 in *Krishnamurthi '929*, *Krishnamurthi '929* does not, and cannot, anticipate Claims 1-3. Based on at least the foregoing, withdrawal of the §102(e) rejection of Claims 1-3 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1-7, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,



Paul J. Farrell
Reg. No. 33,494
Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
Tel: (516) 228-8484
Fax: (516) 228-8516
PJF/RCC/dr